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09/352,734	07/13/1999	JAMES OWEN	SLA0193	2607

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EXAMINER

DANG, DUY M

ART UNIT PAPER NUMBER

2621

DATE MAILED: 02/11/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/352,734

Applicant(s)

OWEN ET AL.

Examiner

Duy M Dang

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11/21/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 06 August 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/21/03 has been entered.

2. Applicant's amendment filed 11/21/03 has been entered and made of record.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9 and 11-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In this case, the limitation of "wherein the control sheet could be located in a position other than that of a cover sheet" recited in lines 5-7 of claims and 1 and 8 was not described in the original specification.

It is noted that this limitation appears to be contradicted to what the original specification describes in page 3 lines 9-10, which states: "In alternative embodiments, the control image could be text, such as a typed or handwritten cover sheet". Since the "a control image" is only included in the control sheet (see claim 1 lines 3-4 for example), and the "control image could be

Art Unit: 2621

a handwritten cover sheet", so the control sheet could not be located in a position other than that of a cover sheet. If it could, please explain how.

Dependent claims 2-7, 9, and 11-15 are also rejected for the same reasons as above.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-9, and 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The new added limitation that of "cover sheet" in line 7 of claims 1 and 8 renders claimed vague and indefinite because it is unclear whether this "cover sheet" refers to document cover sheet (i.e., any page of the document) or facsimile cover sheet. Clarification is required. For prior art comparison, the so called cover sheet is read as any page of the document.

Dependent claims 2-7, 9, and 11-15 are also rejected for the same reasons as above.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-9 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmid et al. (US Patent No. 5,659,164. Art of record IDS (paper #2) filed 10/18/1999).

Regarding claim 1, Schmid teaches a method for controlling scanning device using control sheets (i.e., the "MRI such as the bar-coded information" shown in figure 1 and

Art Unit: 2621

mentioned in col. 4 lines 22-28 functions as the so called “controlling scanning device using control sheets”), comprising the steps of:

starting an imaging job having a multiple sheets (i.e., the “start scanner” shown at 14 of figure 3A; “place stack in feeder” shown in figure 2A; and “preparing a stack of successive sheets...digitizing scanner” mentioned in col. 3 lines 34-41. Also refer to “beginning of the document scanning” mentioned in col. 3 lines 42-43), wherein at least one control sheet is a control sheet containing only a control image (see “cover page 1” comprising MRI and HRI according to figure 1. Note that the MRI and HRI refer to the so called “control image”. This interpretation is consistent with application’s disclosed page 3 lines 9 and 11-12 that of “control image could be a text” and “control image could also be in machine-readable code”);

locating the control image on the control sheet within said imaging job (i.e., the “place documents with cover sheets on scanner feeder” shown at 6 of figure 3A and “recognizing...reading the machine-readable code markings of the cover sheet” mentioned in col. 3 lines 41-44), wherein the control sheet could be located anywhere within the imaging job (see “cover page 1” shown in figure 1. This figure clearly shows that the cover page 1 is located at the different position with other pages of the document);

processing (i.e., the “analyze, recognize” shown at 20 of figure 3B. Also refer to “computer (CP)” shown in figure 2A and mentioned at col. 4 lines 32-37) control instructions (i.e., the “machine code” shown at 20 of figure 3B) from said control image (i.e., the “machine code” shown at 20 of figure 3B and the “MRI” mentioned in col. 4 lines 22-28 correspond to the so called “control instructions”); and

creating output in accordance with said control instructions (i.e., the “recording cover sheet info routing ID, config. parameter, etc.” shown at 24 of figure 3B).

Regarding claim 8, Schmid teaches a method for controlling scanning device using control sheets (see figure 2A and the two cover pages (1 and 1') shown in figure 1) comprising the step of:

starting an imaging job having multiple sheets (i.e., the “start scanner” shown at 14 of figure 3A; “place stack in feeder” shown in figure 2A; and “preparing a stack of successive sheets...digitizing scanner” mentioned in col. 3 lines 34-41. Also refer to “beginning of the document scanning” mentioned in col. 3 lines 42-43), wherein at least one sheet is a control sheet containing only control information (see “cover page 1” comprising MRI and HRI according to figure 1. Note that the MRI and HRI refer to the so called “control image”. This interpretation is consistent with application’s disclosed page 3 lines 9 and 11-12 that of “control image could be a text” and “control image could also be in machine-readable code”);

locating a control image on the control sheet within said imaging job (i.e., the “place documents with cover sheets on scanner feeder” shown at 6 of figure 3A and “recognizing...reading the machine-readable code markings of the cover sheet” mentioned in col. 3 lines 41-44), wherein the control sheet could be located anywhere within the imaging job (see “cover page 1” shown in figure 1. This figure clearly shows that the cover page 1 is located at the different position with other pages of the document);

creating output for said imaging job (i.e., the “recording cover sheet info routing ID, config. parameter, etc.” shown at 24 of figure 3B); and

processing (i.e., the “analyze, recognize” shown at 20 of figure 3B) control instructions (i.e., the “machine code” shown at 20 of figure 3B) from said control image and using said control instruction for managing said output (i.e., the “set scanner parameters command: resolution, dither, mode, etc.” shown at 23 of figure 3B).

Regarding claims 2, and 9, Schmid further teaches an image acquisition task (i.e., the “scanner” shown in figure 2C and mentioned in col. 3 lines 39-41 functions as the so called “an image acquisition task”).

Regarding claims 3, and 11, Schmid further an image production task (i.e., the scanning document and storing document as a digitized document mentioned in col. 5 lines 35-38 functions as the so called “an image production task”).

Regarding claims 4, and 12, Schmid further teaches a machine-readable format (i.e., the stack of pages shown in figure 1 contained printed information according to col. 2 lines 23-27 satisfies the so called “a machine-readable format”).

Regarding claims 5, and 13, Schmid further teaches wherein said control image is text (i.e., the “human readable information (HRI)” shown in figure 1, and “printed information” (i.e., handwritten) mentioned in col. 2 lines 23-28).

Regarding claims 6, and 14, Schmid further teaches wherein said control image is numbers (i.e., the “human readable information (HRI)” shown in figure 1, “MRI” shown in figure 4 (note the numbers printed below barcode), and “printed information” (i.e., handwritten) mentioned in col. 2 lines 23-28 satisfy the so called “numbers”).

Regarding claims 7, and 15 Schmid further teaches wherein said method includes the steps of locating a second control image on the second control sheet containing only the control

Art Unit: 2621

image for the image job ad processing the second control image (i.e., the cover sheet 1' shown figure 1 corresponds to the so called second control sheet containing only the control image.

Note the cover sheet 1' is similar to cover sheet 1 so MRI and HRI are also included in the cover page 1'. Also refer to the "analyze, recognize machine code" shown at 20 of figure 3B).


9. Applicant's arguments filed 11/21/03 have been fully considered but they are not persuasive.

In reply to applicant's remarks with regard to claims 1 and 8 that "HRI of Schmid may reside on the same page as the machine readable information" (see page 4 second paragraph), the examiner agrees. However, both HRI and MRI serve as the control image or control instruction which is consistent with Applicant's disclosure as pointed out in the claim rejection section above. Thus, Schmid meets the claimed features.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M Dang whose telephone number is 703-305-1464. The examiner can normally be reached on Monday to Thursday from 6:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

  
dmd  
2/2/04

  
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